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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHANNAVAJJALA, LAKSHMI SARADA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/614,016

Applicant(s)

DELACOUR ET AL.

Examiner

Lakshmi S. Channavajjala

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-51 and 57-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-51 and 57-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 12-11-08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt of IDS dated 12-11-08; amendment, declaration and remarks dated 12-08-09 is acknowledged.

Claims 5-7, 52-56 are canceled. 1-5, 8-51 and 57-63 are pending in the instant application.

The following rejections applied previously have been maintained:

Double Patenting

Claims **1-5, 8-51 and 57-63** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,689,345. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Instant claims recite a cosmetic composition comprising a binder comprising water and particles of cross-linked elastomeric organosiloxane (phase C), and a particulate phase (phase B), with the ratio of 0.4:1 to 1.8:1 and the ratio of the binder to the phase B is from 1:1 to 2.5:1. The composition of the instant claims has a pasty to pulverulent texture.

The patented claims recite a make-up composition wherein the composition comprises particles of elastomeric organosiloxane suspended in water phase and the patented composition is also used for the same cosmetic purposes claimed in the instant application. Dependent claims of the cited patent recite the particle sizes of the organosiloxane, aqueous phase gelling agents, fatty substances, waxes, and volatile oils etc., all of which are recited in the instant claims. Further, the dependent claims of

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the patent (48-54) recite fillers, nacres and pigments respectively, which are defined by the patent as particulate materials and include the claimed fillers and pigments respectively and include the same materials that are claimed in the instant applications. Furthermore, the patent claims same cosmetic forms or products such as solid foundation powders that read on the claimed pulvulent mixtures, foundation etc., that are within the scope of the instant claims. While the patented claims do not recite the exact ratios of the instant claims, they recite the amounts of the organopolysiloxane and the particulate phase (see claims 11-12 and 33-34), particle sizes and hardness range that is within the claimed ranges and also suggest different consistencies or forms of the cosmetic composition such as powders, sticks. Accordingly, preparing a cosmetic/make up composition of desired consistency or form such as powder or foundation or stick form by choosing the appropriate amounts of the individual components i.e., polyorganosiloxane, particulate phase, water and other components claimed in '345 it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts or ratios of the polyorganosiloxane and the particulate phase because the patented composition is used to prepare the same cosmetic products that are also claimed in the instant application.

Claims 1- 63 directed to an invention not patentably distinct from claims 1-63 of commonly assigned US 6,689,345. Specifically, the patent method recites a composition that renders the instant composition obvious for the reasons mentioned above.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,689,345, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

Applicant's arguments filed 12-8-08 have been fully considered but they are not persuasive.

Applicants argue that the specification should not be used as a basis for analyzing the claims in a double patenting rejection. In response to this, examiner has not relied on the specification of '345 for the claimed composition and instead only for the scope of the particulate phase of the patented claim 33, which the patent defines to

include the nacres, filler, pigments etc., which are also present in the patented claims. It is argued that '345 is filed earlier than the instant application and therefore a one-way test should be applied in determining if double patenting exists between instant and the patented claims. The rejection clearly explains how the patented claims constitute an obvious variation of the instant claims, particularly, because the patented claims include all of the claimed components and the claimed forms such as foundation (claim 58 of patent and also instant application) and also claim 38 of the patent recites different cosmetic forms that are also claimed in the instant claim 58. The only difference being the ratios of the phases A to B and phases to B to C. A skilled artisan would have been able to optimize the amounts (and hence the ratios) of the components such as water, organopolysiloxane and the particulate materials (fillers, nacres, pigments etc.,) of the patented claims in order to successfully prepare a powder or a solid stick etc., in the claimed composition of '345 patent. Thus, the above cosmetic forms of the patented claims provide the desirability of the instant claimed textures.

With respect to the results provided in the declaration under 37 CFR 1.132 of Marie-Laure Delacour, the examiner has considered the declaration, which is not found persuasive because the results presented in the declaration are not of the same scope of the instant claims. Instant claim 1 requires a particulate phase which is very broad and the dependent claims such as claims 16-30 require the presence of at least one particulate material. The claimed invention requires one particulate material in combination with any organopolysiloxane C, whereas the composition in the declaration tested includes a specific organopolysiloxane BY29119 in combination with a specific

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particulate phase made of several materials such titanium oxide, yellow iron oxide, black iron oxide, nylon powder and brown/yellow iron oxide. Thus, the composition employed in the comparative tests is not representative of the broad scope of the claimed invention. However, assuming that the composition is of the same scope of the claimed invention, then the results provided are not unexpected from the teachings of the '345 claims because '345 does teach the claimed composition with the same components. A skilled artisan would have been able to optimize the amounts of the components such as water, particulate phase and organosiloxane to obtain a desired texture of the final composition. A skilled artisan would have readily recognized that a paste composition requires more of water containing phase than a powdery composition, which is also implied from the declarative results. The comparative compositions (2 and 3) comprising lower amount of the water (and BY29119) containing phase are easily crumbled and not able to maintain a shape than the inventive compositions that contain more of a water (and BY29119) phase that are able to maintain the shape due to the cohesive and elastic nature of the composition. A skilled artisan practicing the invention of '345 claims would have been able to alter the amounts of the water and organosiloxane with respect to the particulate phase in order to prepare a solid stick composition that maintains a shape or a powder that is loose and particulate.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims **1-5, 8-51 and 57-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over US patents 6,403,704 ('704) or US 6,689,345 ('345) or US 6,565,862('862).

Examiner herewith clarifies that the rejection of claims over US 7,094,842 ('842) is no longer present and withdrawn for the reasons mentioned in the office action dated 9-17-07.

'704 teach cosmetic skin care compositions comprising particles of at least a partially crosslinked elastomeric polyorganosiloxanes suspended in an aqueous phase, wherein the polymer dryness as well as a matte finish to the cosmetic composition when applied (col. 2, L 23- 59). Both instant specification and '704 refer to the same polysiloxane compounds described in JP-A-10/175816 application for the suitable polyorganosiloxanes compounds that are suitable for the instant invention, particularly, those sold under the trade names BY-29-122, BY-29-119 (also disclose in the instant specification) (col. 3, L 37-59 & col. 4, L 10-40) having the same hardness and particle sizes recited in the instant claims. For microcrystalline wax of claims 32 -35, see col. 5, L 50-55. For volatile oils of claims 36-38, see col. 4, last paragraph through col. 5. For gelling agents of claims 39-43, see col. Col. 6, l 4-40. For the pigments, fillers and nacles (read on instant pearlescent agents) see entire col. 7. '704 teach preparing the composition by a screw extruder mixer and thus meet claimed method of preparing the composition (claims 51-60), where the polyorganosiloxanes is added to water and

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mixing with the pigment or filler materials that are particulate in nature. '704 further teach the same solid compositions claimed (col. 49-59). '704 do not teach the claimed ratios of the particulate phase and binder. However, '704 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. Further, '704 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

'862 also teach cosmetic composition comprising the claimed binder and particulate material and for the preparation of the same cosmetic compositions such as those claimed. The disclosure of '862 and '704 are similar in that the former also teach the same polymers as suitable for binder phase, and also teach the fillers, pigments, nacles, fatty phase, waxes and gelling agents etc. '862 also describe the same advantages such as those described by '704 with the composition. '862 fail to teach the claimed ratios or percentages of the components A, B and C. However, '862 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. Further, '862 teach that the composition

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provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

'345 cosmetic compositions comprising the claimed organosiloxane elastomeric polymers (col. 4, L 55 through col. 6, L 67) and are similar to those of '704 and '862. '345 also teach the claimed fatty phase, particle sizes (col. 7), containing microcrystalline wax (col. 8, L 56-65), gelling agents (col. 8, L 38 through col. 9, L 20), particulate pigments, fillers, nacles (col. 9) and the same method of producing the composition (twin screw extruders- col. 10). '345 fail to teach the claimed ratios or percentages of the components A, B and C. However, '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58 and teaches etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51). Further, '345 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase,

gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

Response to Arguments

Applicant's arguments and the declaration under 37 CFR 1.132 of Marie-Laure Delacour filed 12-8-08 have been fully considered but they are not persuasive.

Applicants reiterated the arguments presented on 3-17-08. They argue that '704, '862, and '345 patents teach eye shadows, they do not teach the desirability of a pasty-pulverulent mixture of instant composition with the claimed ratios. It is argued that without any specific guidance from these references, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '704, '862, and '345 patents by picking and choosing the particular claimed ratio of organopolysiloxane to particulate phase to achieve the present invention, as alleged by the Examiner.

Applicants' arguments are not persuasive because even though patented claims of '704, '862, and '345 do not teach the claimed ratios, they teach the amounts of organopolysiloxane and the particulate phases in terms of percentages. Further, the motivation to optimize the amounts or the ratios of the above comes from the fact the patented claims recite make up or cosmetic compositions in the form of foundation, powders (reads on instant pulverulent mixture) i.e., cosmetic or make up products such as a foundation, eye shadows etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51) in 345 patent, powder in '704 (col. 6, l 51) and as a paste for in '862 patent (col. 3, l 42-45). The argument that the examples do not teach the claimed ratios and instead provide a general guidance is not persuasive because the references

teach all of the components claimed and also desire the claimed texture of the make up composition and therefore optimizing the individual components so as to arrive at the claimed texture i.e., a paste or a powder would have been within the scope of a skilled artisan, with a reasonable expectation of success. Furthermore, the teachings of the prior art are not limited to examples or preferred embodiments and instead should be considered as a whole. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. In *re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

With respect to the argument regarding why one of ordinary skill in the art would have been motivated, either by the cited art or by knowledge generally available to the skilled artisan, to modify the composition of any of the '704, '862, and '345 patents by incorporating therein the organopolysiloxane and particulate phase in amounts sufficient to arrive at the claimed ratio (i.e., from 0.4:1 to 1.8:1 as recited in e.g., claim I), as explained above the patents teach various cosmetic forms from pastes, solids to loose powders and a skilled artisan would have been able to vary the amounts of water, particulate phase and organopolysiloxane so as to achieve the desired consistency of the composition because a skilled artisan would have readily recognized that a paste composition requires more of water containing phase than a powdery composition.

Applicants urge that their position is further supported by Table 1 below, which lays out the disclosed concentrations of organopolysiloxane and particulate phase and the resulting range of ratios suggested to the skilled artisan by such disclosures. It is stated that as indicated in Table 1, the '704, '862, and '345 patents teach such widely varied concentrations for the organopolysiloxane and particulate phase, it cannot reasonably be said that such broad disclosures would lead one of ordinary skill in the art to optimize the concentrations to arrive at the presently claimed ratio (presently amended claim 1). It is argued that none of the relevant examples of the '704, '862, and '345 patents teach the presently claimed organopolysiloxane/particulate phase ratio (presently amended claim t). Thus, it is argued that the only specific guidance provided by the '704, '862, and '345 patents, other than the general disclosures of these references, does not lead the skilled artisan to the claimed ratio, but rather, leads the artisan from the claimed ratios.

In this regard, applicants submitted the declaration under 37 CFR 1.132 of Marie-Laure Delacour. It is argued that inventive compositions 1 and 4 are within the scope of the instant claims and comparative compositions 2 and 3 are outside the scope of the pending claims. It is argued that the declaration compares compositions that are closer than the prior art applied by the examiner and that the results are significant. It is argued that the inventive compositions 1 and 4 provide a pulverulent-to-pasty texture whereas the comparative compositions provide a crumbly, powdery texture and unable to retain the shape.

With respect to the results provided in the declaration under 37 CFR 1.132 of Marie-Laure Delacour, the examiner has considered the declaration, which is not found persuasive because the results presented in the declaration are not of the same scope of the instant claims. Instant claim 1 requires a particulate phase which is very broad and the dependent claims such as claims 16-30 require the presence of at least one particulate material. The claimed invention requires one particulate material in combination with any organopolysiloxane C, whereas the composition in the declaration tested includes a specific organopolysiloxane BY29119 in combination with a specific particulate phase made of several materials such titanium oxide, yellow iron oxide, black iron oxide, nylon powder and brown/yellow iron oxide. Thus, the composition employed in the comparative tests is not representative of the broad scope of the claimed invention. However, assuming that the composition is of the same scope of the claimed invention, then the results provided are not unexpected from the teachings of the '345, '704 and '862 patents because the said patents do teach the claimed composition with the same components. They also teach (as explained above) different textures of the composition such as powders, pastes, solid stick etc. A skilled artisan would have readily recognized that a paste composition requires more of water containing phase than a powdery composition, which is also implied from the declarative results. Accordingly, a skilled artisan would have been able to optimize the amounts of the components such as water, particulate phase and organosiloxane to obtain a desired texture of the final composition. Further, the comparative compositions (2 and 3) comprising lower amount of the water (and BY29119) containing phase are

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easily crumbled and not able to maintain a shape than the inventive compositions that contain more of a water (and BY29119) phase that are able to maintain the shape due to the cohesive and elastic nature of the composition. A skilled artisan practicing the invention of '345, '704 and '862 patents would have been able to alter the amounts of the water and organosiloxane with respect to the particulate phase in order to prepare a solid stick composition that maintains a shape or a powder that is loose and particulate.

The following is a new rejection, in addition to the above rejections:

Claims **1-5, 8-51 and 57-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over US EP 1064930 (EP) or JP 2000103717 (JP 717, abstract only) in view of EP.

The examiner relies on US Patent 6,689,345 for the English translation of EP reference because the US patent 345 relies on the EP application for foreign priority. The teachings of US 345 have been discussed in the preceeding rejection (#4). Accordingly, for the reasons mentioned above, it would have been obvious for a skilled artisan at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness because '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same

purpose i.e., cosmetic or make up products such as a foundation, eye shadows etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51).

Alternatively, JP (abstract) teaches a solid cosmetic composition having excellent stability to impact even when mixing a large amount of spherical powder of an organopolysiloxane elastomer (abstract). The composition of JP comprises 0.1% to 50% by wt of organopolysiloxane spherical powder having 50-100 or 50-80 JIS hardness and a particle size of 0.1-200 microns. JP teaches preparing the cosmetic in the form of powdery foundation, or other kinds of foundations, rouges etc., and teaches preparing the spherical powder by dispersing organopolysiloxane in water. JP fails to teach the claimed particulate phase B in the composition and the additional components claimed in the instant application i.e., fillers, pearlescent materials, oils, wax, gelling agents etc. of the instant claims.

EP (US 345), discussed above, teaches all of the claimed oils, wax, gelling agents in col. 7-8, fillers, pigments and nacreous material in col. 10, all of which are also described in the instant application. Further, EP (US 345) also teaches the same cosmetic formulations such as foundation powders, rouges and other forms taught by JP. Therefore, it would have been obvious for a skilled artisan at the time of the instant invention to include the cosmetic additives such as fillers, pearlescent materials, oils, wax, gelling agents etc. of EP (US 345) depending on the desired consistency and effect, in the composition of JP because both JP and EP are directed to preparing the same type of cosmetic compositions comprising the same type of organopolysiloxane materials (including hardness and particle sizes) and according to EP the instant

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claimed materials are conventionally used in preparing the described cosmetic make up compositions such as foundations, powders etc. With respect to the claimed ratios, as explained above, '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadows etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51) and JP also teaches percentages of organopolysiloxanes, both for preparing the same type of compositions i.e., powdery foundations etc. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides the desired finish and strength.

Response to Arguments

Applicant's arguments and the declaration under 37 CFR 1.132 of Marie-Laure Delacour filed 12-8-08 have been fully considered but they are not persuasive.

Applicants argue that while examiner relied on US '345 patent for a complete translation of the EP patent, '345 patent does not disclose the claimed ratios and in fact teaches away from the instant invention. Further, applicants refer to the declaration under 37 CFR 1.132 of Delacour for the unexpected results. However, applicants' arguments are not persuasive because as explained previously, '345 teach the amounts of organopolysiloxane and the particulate phases in terms of percentages. Further, the motivation to optimize the amounts or the ratios of the above comes from the fact the

patent recites make up or cosmetic compositions in the form of foundation powders (reads on instant pulverulent mixture) i.e., cosmetic or make up products such as a foundation, eye shadows etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51) in 345 patent. The argument that the examples do not teach the claimed ratios and instead provide a general guidance is not persuasive because the references teach all of the components claimed and also desire the claimed texture of the make up composition and therefore optimizing the individual components so as to arrive at the claimed texture i.e., a paste or a powder would have been within the scope of a skilled artisan, with a reasonable expectation of success. Furthermore, the teachings of the prior art are not limited to examples or preferred embodiments and instead should be considered as a whole. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

With respect to the argument regarding why one of ordinary skill in the art would have been motivated, either by the cited art or by knowledge generally available to the skilled artisan, to modify the composition of any of the '704, '862, and '345 patents by incorporating therein the organopolysiloxane and particulate phase in amounts sufficient to arrive at the claimed ratio (claim I), as explained above the patents teach various

cosmetic forms from pastes, solids to loose powders and a skilled artisan would have been able to vary the amounts of water, particulate phase and organopolysiloxane so as to achieve the desired consistency of the composition because a skilled artisan would have readily recognized that a paste composition requires more of water containing phase than a powdery composition.

Applicants argue that JP '717 admittedly fails to teach the particulate phase and EP 930 fails to cure the deficiencies of JP 717. It is argued that while the examiner again relies on EP 930 for the motivation to optimize the amounts of particulate and organosiloxane phases, EP '930 fails to disclose the claimed ratios that provide unexpectedly improved texture, cohesion etc. It is argued JP 717 is silent regarding the ratios and nothing in EP 930 establishes prima-facie case of obviousness.

Applicants' arguments are not persuasive because EP '930 (evidenced by '345 patent) teaches the claimed components and also teaches the amounts of the components in terms of percentages and not ratios. Examiner explained in the preceding paragraphs how and why the teachings of US 345 patent render instant claims prima facie obvious even in light of the declaration. With respect to JP '717, the rejection clearly admits that JP fails to teach the particulate phase of the instant and relies on the teachings of EP 930 ('345) for the same. The motivation to include the particulate materials of EP 930 in the composition of JP 717 comes from the analogous nature of both the references, directed to cosmetic foundations, powders, pastes, solid stick etc. EP 930 (345 patent) suggests that the particulate fillers provide modified texture to the composition and pigments impart color to the composition. US 345

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suggests that the composition comprising organosiloxane, fibers and particulate fibers can be made a paste, powders etc., and provide a homogenous, uniform make-up with sharp contours when applied, accompanied by and also renders matte-effect and water resistant properties. Thus, the resulting composition of JP and EP provides the claimed paste to a pulverulent texture depending on the amounts of the individual components employed.

With respect to the declaration of Delacour, the examiner has provided a detailed reasoning as to why the results are not persuasive in the preceding paragraphs and are incorporated here.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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